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2-Art Unit PAPER NUMBER

23

DATE MAILED: 11/06/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.	Applicant(s)	
Examiner	Group Art Unit	

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

Responsive to communication(s) filed on 8-18-98.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

Claim(s) 1-13 and 40-44 is/are pending in the application.

Of the above claim(s) NONE is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-13 and 40-44 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

### Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of References Cited, PTO-892

Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948

Other \_\_\_\_\_

## Office Action Summary

### Part III DETAILED ACTION

1. This action is responsive to communications: amendment filed 8/18/98 to the application filed 8/8/97, which is a FWC of the application Ser. No. 09/378,819, filed 1/27/95.
2. In the amendment claims 24-35 and 39 have been canceled and claims 40-44 have been added. Accordingly, claims 1-13 and 40-44 are pending in this case.

#### *Priority*

3. Receipt is acknowledged of papers submitted under 35 U.S.C. § 119, which papers have been placed of record in the file.

#### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371<sup>¶</sup> of this title before the invention thereof by the applicant for patent.

5. Claims 1-4 remain rejected under 35 U.S.C. 102(e) as being anticipated by Bonomi, U.S. Pat. No. 5,577,191, 11/96 (filed 2/94).

As per independent claim 1, Bonomi discloses the following claimed elements of a moving image editing apparatus:

- decoding means for decoding moving image data encoded by an encoding method that includes encoding in which interframe correlation is considered (col.2, line 54, "The video compression circuit ...compress the video data ...using both interframe and intraframe algorithm ...[and the] video decompression circuit decompresses intraframe-only compressed video data to allow editing");
- storing means for intraframe coding the decoded moving image data and storing the intraframe encoded image data (col.4, line 25, "...in FIG.2, intraframe-only compressed video data is retrieved from storage" shows that the data have been stored.);
- editing means for decoding the image data which was stored in said storing means and intraframe encoded, and for performing an arbitrary editing on the encoded image data (col.2, line 57, "intraframe-only compressed video data ...allow video editing to occur in the host processor."); and
- coding means for coding the edited image data by an encoded method that includes encoding in which the interframe correlation is considered (col.2, line 59, "When the video editing is complete, the video ....the video compression circuit to compress the video data using both intraframe and interframe algorithm. ").

As per dependent claim 2, Bonomi discloses that the **animating image data is transmitted from an external apparatus by communication** (see "VTR", item 101, in FIGs. 1 and 2).

As per dependent claim 3, Bonomi discloses an edition in a time base direction between frames (col.1, line 52, "Typical editing activities include special effects, titling, mixing, fades and wipes...").

As per dependent claim 4, Bonomi discloses displaying the decoded image data (col.3, line 52, "...decompressed the video data to display the video images on display").

*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

7. Claims 5-13 remain rejected and claims 40-42 are rejected under 35 U.S.C. § 103 as being unpatentable over Bonomi in view of Normille et al., U.S. Pat. No. 5,267,334, 11/93.

As per independent claim 5, Bonomi further teaches arbitrary editing and encoding the edited frame images (col.3, line 62, "Video editing can be accomplished using video editing software ...[on] host computer [which] retrieves selected frames..."), but does not explicitly teach the actual implementation of the decoding. However, Normille teaches the missing

limitations: **detecting an intraframe** (col.7, line 59, "detecting a first scene ...known, in a preferred embodiment, as a ...intra frame"); and **decoding the image and a predetermined number of frames after the detected image** (col.7, line 66, "generating at least one intermediate compressed frame...containing difference information from the first image for at least one image following the first image in time in the sequence of moving images"). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have used Normille's detection and decoding means to decode Bonomi's compressed images, since Bonomi explicitly taught that the compression was done using both intraframe and interframe encoding, which was the same encoded frames that Normille used in decoding.

As per the limitation of decoding the moving image data of a predetermined number of frames including images to be edited by using the frame detected by the intraframe detecting means. Nevertheless, including the image to be edited in the decoded frames would have been obvious to a person of ordinary skill in the art at the time the invention was made, since Bonomi disclosed the motivation by teaching that "Video editing requires random access to frames...Thus, existing video editing systems use only intraframe compression (col.2, lines 6-12)" In other words, since Normille disclosed the interframe coded set of frames, Bonomi pointed out that they must be decoded into independent frames before editing take place.

As per dependent claim 6, Bonomi discloses that the intraframe encoded images after edited is recorded and stored in intraframe coding (col.2, line 59, "When the video editing is complete, the video ....the video compression circuit to compress the video data using both intraframe and interframe algorithm.").

Dependent claims 7 and 8 recite substantially similar limitations as those in claim 2, and are similarly rejected under the same rationale.

Dependent claims 9 and 10 recite substantially similar limitations as those in claim 3, and are similarly rejected under the same rationale.

As per dependent claims 11 and 12, Bonomi discloses decoding from the intraframe just before the frame to be edited (col.4, line 2, "...decompression and display on display ..[for] video editing").

Dependent claim 13 recites substantially similar limitations as those in claim 4, and is similarly rejected under the same rationale.

As per dependent claims 40-42, Bonomi disclose the means for editing by selecting image frames. Therefore, the means for cutting a frame and inserting a frame would have been obvious to a person of ordinary skill in the art at the time the invention was made, since such means were well known elements of editing frames.

8. Claims 43 and 44 are rejected under 35 U.S.C. § 103 as being unpatentable over Bonomi in view of Nguyen, U.S. Pat. No. 5,404,437, 4/95 (filed 11/92).

As per dependent claims 43 and 44, Nguyen discloses animation images displayed in multi-screen displays that are obtained by reducing the frame images (FIG.9 and col.9, lines 15-30). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined the teachings of Nguyen and Bonomi, since Nguyen taught the specific features of editing animation frames, and Bonomi explicitly suggested

performing animation frame editions (col.1, line 52, "editing activities include special effects ...").

*Response to Amendment*

9. Applicant's arguments filed 8/18/98 have been fully considered but they are not persuasive.

Applicant notes that a sworn translation of the priority document is being prepared to overcome the prior art of Bonomi. Therefore, when it is submitted Examiner will consider the priority document.

*Conclusion*

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Hong whose telephone number is (703) 308-5465. The examiner can normally be reached on Monday-Friday from 8:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 305-9701.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

**Any response to this final action should be mailed to:**

**Box AF**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 308-9051, (for formal communications; please mark "EXPEDITED PROCEDURE")

**Or:**

(703) 305-9724 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

*Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).*  
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

For any written or facsimile communication submitted ON OR AFTER APRIL 26, 1998, this Examiner, who was assigned to Art Unit 2772, will be assigned to **Art Unit 2776**. Please include the new Art Unit in the caption or heading of any communication submitted after the APRIL 26, 1998 date. Your cooperation in this matter will assist in the timely processing of the submission and is appreciated by the Office.

  
Stephen Hong

Primary Examiner

November 5, 1998